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**GROUP 1600**

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**DATE:** January 8, 2001  
**TO:** Examiner J. Uhm  
**COMPANY:** USPTO  
**FAX NO.:** 703-308-4242  
**TELEPHONE NO.:** 703-308-4008  
**FROM:** Diana Hamlet-Cox, Ph.D.  
**OUR REF. NO.:** PF-0339-1 DIV  
**YOUR REF. NO.:** U.S. Serial No. 09/265,710  
**PAGES :** 4

Please see the attached.

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CERTIFICATE OF TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the attention of Examiner Ulm, J., Group Art Unit 1646, U.S. Patent and Trademark Office to Facsimile No. 703-308-4242 on the date shown below.

Nancy Koyan  
Signature

1/8/01  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE JAN 9 2001

**GROUP 1600**

In re Application of: Bandman et al.

Title: NEW HUMAN INTEGRAL MEMBRANE PROTEIN

Serial No.: 09/265,710

Filing Date: March 9, 1999

Examiner: Ulm, J.

Group Art Unit: 1646

Commissioner for Patents  
Washington, D.C. 20231

OFFICIAL

**REQUEST FOR NEW OFFICE ACTION and RESETTING OF THE PERIOD FOR RESPONSE**

Sir:

Attached is a copy of pages 2 and 3 of the Office Action dated November 14, 2000, in the above-identified application, received by the Assignee on November 20, 2000.

When the undersigned reviewed the Office Action in order to prepare a response thereto, it was noted that the Office Action is incomplete, in that page 2 ends in a complete sentence, while page 3 begins in the middle of a sentence. There is obviously text missing from the Office Action, making it impossible to respond thereto.

Applicants respectfully request that a new Office Action be prepared, and that the statutory time period for response be reset.

Applicants believe that no fee is due with this paper. However, if the Commissioner determines that a fee is necessary, the Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 09-0108. A duplicate of this communication is enclosed.

Respectfully submitted,

INCYTE GENOMICS, INC.

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Diana Hamlet-Cox

Art Unit: 1646

1) Claims 1, 2, 12 to 18, 21, 23 to 35, 40 and 41 are pending in the instant application. Claims 1, 2, 12 and 21 have been amended, claims 22 and 36 to 39 have been canceled and claim 41 has been added as requested by Applicant in Paper Number 8, filed 22 August of 2000.

2) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4) Claims 13 to 18, 23 to 35 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

5) Newly submitted claim 41 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 41 is drawn to a method of using an antibody that is the subject of invention II in Paper Number 5, which is a nonelected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 41 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Art Unit: 1646

established utility for those reasons of record in section 4 of Paper Number 7. Applicant has traversed this rejection on the premise that a "purified human integral membrane protein" of the instant invention can be employed as an osteoblast marker. This is not a credible utility because there is no evidence of record that the disclosed protein is differentially expressed in osteoblasts. At best, the instant specification discloses that the protein described therein is structurally similar to a different protein which is known to be differentially expressed in osteoblasts. There is absolutely no evidence of record that similarity of structure between two proteins is predictive of a similarity in expression pattern of those proteins. Therefore, one of ordinary skill would not conclude that a protein of the instant invention could be employed as a tissue marker based sole on the similarity of that protein to a different protein.

Further, the employment of a protein of the instant invention, or a nucleic acid encoding that protein, as a tissue specific marker is not a substantial or specific utility. All human proteins can invariably be classified into two categories, those which are expressed in a tissue or developmentally specific manner and those which are expressed ubiquitously. It can be alleged that any protein which is expressed in a tissue specific manner can be employed to detect the tissue in which it is expressed in a sample. Alternately, a human protein which is expressed ubiquitously can be employed to detect the presence of any human tissue in a sample. Such utilities are analogous to the assertion that a particular protein can be employed as a molecular weight marker, which is neither a specific or substantial utility.